

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TAKAHIRO HIRAISHI, KYOKO MATSUMOTO,
ANDREW MALCOM MURRAY and
TADASHI NUMATA

Appeal No. 2003-0862
Application No. 09/518,032

ON BRIEF

Before WINTERS, SCHEINER and MILLS, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 1-12 which are all of the claims pending in this application.

Claims 1 and 8 are illustrative of the claims on appeal and read as follows:

1. Hair treatment composition comprising a silicone component which comprises a silicone gum with a viscosity greater than 1 Mcs, a silicone fluid with a viscosity of less than 100 Kcs, and an amino functionalised silicone, wherein said viscosity is measured by means of a glass capillary viscometer as set forth in Dow Corning Corporate Test Method CTM004.

8. A composition according to claim 1, wherein the silicone component is in the form of a mechanical emulsion.

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The prior art references relied upon by the examiner are:

Murray et al. (Murray)	5,439,673	Aug. 8, 1995
Dowell et al. (Dowell)	5,587,154	Dec. 24, 1996

Grounds of Rejection

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as obvious over Murray.

Claims 1-7 and 9-12 stand rejected under 35 U.S.C. § 103(a) as obvious over Dowell.

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as obvious over Murray in combination with Dowell.

Claims 1-12 stand rejected for obviousness-type double patenting over claims 1 and 2 of U.S. Patent No. 6,048,519.

We affirm each of the above rejections.

Claim Grouping

According to appellants, claims 1-7 and 10-12 stand or fall by themselves as a group. Brief, page 11. In addition, claims 8 and 9 stand by themselves as a group. We treat the claims subject to each rejection separately. In re McDaniel, 293 F3d 1379, 63 USPQ2d 1462, 1466 (Fed. Cir. 2002). Individual claims in each group are not argued separately. Therefore, we select claim 1 as representative of group 1, claims 1-7 and 10-12, and claim 8 is representative of group 2, claims 8 and 9. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

DISCUSSION

In reaching our decision in this appeal, we have given consideration to the appellants' specification and claims, to the applied references, and to the respective positions articulated by the appellants and the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the noted rejections, we make reference to the examiner's Answer for the examiner's reasoning in support of the rejection, and to the appellants' Brief for the appellants' arguments thereagainst. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 103(a)

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as obvious over Murray.
Claims 1-7 and 9-12 stand rejected under 35 U.S.C. § 103(a) as obvious over Dowell.
Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as obvious over Murray in combination with Dowell.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). It is well-established that the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge

generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Murray

With respect to claim 1, the examiner's position is that Murray discloses a hair care composition comprising 0.0001 to 0.4% by weight of a silicone conditioning agent. Murray discloses that the silicone conditioning agent comprises volatile silicones, non-volatile silicones and mixtures thereof. Murray, column 3; Answer, page 4. The non-volatile silicone component may be a mixture of more than one non-volatile silicone. Id. The non-volatile silicone fluids include silicone fluids and silicone gums. The examiner finds that Murray discloses dimethicone silicone fluids and dimethicone silicone gums having the claimed viscosity. Id. Amino functionalised silicones are also disclosed. Murray, column 4. Murray discloses that when highly viscous silicones are used they may be incorporated into a volatile silicone solvent, which according to the examiner, exhibits the instantly claimed viscosity. Answer, page 4. With respect to claim 8, a mechanical emulsion is disclosed in Murray at column 6. The examiner acknowledges that Murray does not explicitly teach the combination of all three silicones. Answer, page 5.

The examiner concludes from the teachings of Murray, however, that “one would obtain a silicone conditioning agent comprising any combination of a silicone fluid, a silicone gum and an amino functional silicone incorporated into a volatile silicone. The conditioning agent is then incorporated into a hair care composition.” Answer, page 4.

We agree that the examiner has provided sufficient evidence to establish a prima facie case of obviousness based upon Murray. We initially note that claim 1 is a broad claim including open ended claim language and claiming each silicone ingredient in broad terms which encompass a class of silicone compounds, and is not limited to three specific silicone compounds in combination.

Murray teaches a silicone conditioning agent which may incorporate a non-volatile silicone gum having the claimed viscosity into a volatile silicone solvent. Murray discloses volatile silicone solvents having a viscosity as in claim 1. Amino functional silicones are also disclosed. While Murray does not explicitly disclose an example having all three silicone components as claimed, Murray does specifically disclose a preference for mixtures of non-volatile silicones with volatile silicones, and mentions that amino functional silicone conditioning agents are useful in Murray’s hair care compositions.

Where the prior art, as here, gives reason or motivation to make the claimed invention, the burden then falls on an appellants to rebut that prima facie case. Such rebuttal or argument can consist of any other argument or presentation of evidence that is pertinent. In re Dillon, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir.

1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Appellants argue that Murray discloses a number of possible conditioning agents with millions of possibilities. Brief, page 12. Appellants argue that nothing in Murray specifically points to the combination of high volatile silicone, low volatile silicone and amino functionalized silicone. Brief, page 13. Appellants cite In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) in support of the position that a reference which discloses a vast number of compounds encompassed by a generic formula does not render obvious a claim to three compounds “particularly when that disclosure indicates a preference leading away from the claimed compounds.” Brief, page 14.

In Baird, a generic diphenol formula of a reference patent encompassed the bisphenol A of the claimed invention. In that set of facts, the Baird court found that the fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. In Baird the prior art indicated a preference for derivatives of bisphenol A. The court in Baird referenced In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992). Jones involved an obviousness rejection of a claim to a specific compound, the 2-(2'-aminoethoxy) ethanol salt of 2-methoxy-3,6-dichlorobenzoic acid (dicamba), finding the compound obvious in view of a prior art reference disclosing a genus which admittedly encompassed the claimed salt. The court reasoned that the prior art reference encompassed a "potentially infinite genus" of salts of dicamba and listed several such salts, but that it did not disclose or suggest the specifically claimed salt. Id. Neither of

these sets of facts are before us.

We do not find the factual scenario present in Baird to be before us here. In the present case Murray clearly discloses a preference for dissolving a highly viscous silicone, such as a silicone gum, in a volatile silicone solvent. Murray, column 5. Murray also indicates that amino functional silicones are also appropriate for use specifically as silicone conditioning agents. Murray, column 4. Thus, Murray indicates the claimed components and combinations are preferred, and does not, as in Baird, lead away from selecting these preferences.

Furthermore, in the present case, appellants are not claiming a composition limited to a combination of three specific compounds. Appellants claim a hair care treatment composition broadly, including three generic groups of compounds, each generic group also encompassing a vast number of compounds. Thus, we are not persuaded by appellants' reliance on Baird or its applicability to the facts of the present case.

Dowell

With respect to Dowell, the examiner argues that Dowell evidences a hair shampoo including a surfactant, a water-insoluble hair treating compound, a suspending agent and a carrier. Answer, page 6. Dowell discloses that the water-insoluble hair treating compound can be a silicone conditioning agent made of a mixture of low molecular weight dimethylpolysiloxane and a high molecular weight

polydimethylsiloxane gum. Id. Additional water insoluble conditioning compounds may be added to the composition such as amino functional silicones. Dowell, column 12; Answer, page 6. Other various silicone mixtures are described in Dowell. As to claim 8, Dowell describes preparation of emulsions using moderate agitation. Columns 17, 19 and 20.

We again agree that the examiner has presented sufficient evidence to support a prima facie case of obviousness with respect to claims 1 and 8.

Appellants present rebuttal argument similar to that presented in rebuttal of Murray. In particular, appellants argue that Dowell teaches “just a list of various classes of possible conditioning agents, it can easily be seen that millions of possible conditioning agents are disclosed in the ‘154 patent.” Brief, page 16. The appellants find “[n]o mention [in Dowell] .. of silicone conditioning agents of amino functionalized silicones.” Id.

We are not persuaded by this argument. Dowell clearly indicates that a silicone gum may be used in combination with a volatile silicone ingredient. Dowell, column 10, lines 7-15. Dowell, column 12, lines 22-45 reasonably suggests that amino functionalized silicones may also be incorporated into the water soluble conditioning compounds. Such water soluble conditioning compounds may contain a silicone gum in combination with a volatile silicone ingredient. Dowell, column 10.

Moreover, appellants are not claiming a combination of three specific compounds. Appellants claim a hair care treatment composition including three classes or categories of compounds, which also encompass a vast number of compounds, including those described in Dowell.

In our view, appellants have not provided sufficient argument or evidence to rebut the examiner's prima facie case of obviousness. The rejection of claims 1 and 8 as representative of the claims before us in view of Dowell is affirmed.

Combination of Murray and Dowell

We note, as did the examiner (Answer, page 9) that appellants have not responded to the rejection of the claims based on the combination of Murray and Dowell. We summarily affirm this rejection, in the absence of any argument by appellants.

Obviousness-Type Double Patenting

The appellants have not responded to the examiner's rejection of the claims for obviousness-type double patenting in a substantive manner. Appellants have indicated in the Brief, page 10, a willingness to file a terminal disclaimer to respond to this rejection once allowable subject matter is indicated in the application.

In the absence of any rebuttal argument to the rejection of the claims for obviousness-type double patenting, the rejection is affirmed.

CONCLUSION

The rejection of claims 1-12 under 35 U.S.C. § 103(a) as obvious over Murray is affirmed. The rejection of claims 1-7 and 9-12 under 35 U.S.C. § 103(a) as obvious over Dowell is affirmed. The rejection of claims 1-12 under 35 U.S.C. § 103(a) as obvious over Murray in combination with Dowell is affirmed. The rejection of claims 1-12 for obviousness-type double patenting over claims 1 and 2 of U.S. Patent No. 6,048,519 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

SHERMAN D. WINTERS
Administrative Patent Judge

TONI R. SCHEINER
Administrative Patent Judge

DEMETRA J. MILLS
Administrative Patent Judge

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